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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,104	03/31/2004	Paul Buchheit	Google-74 (GP-282-00-US)	5182
26479	7590	09/23/2008	EXAMINER	
STRAUB & POKOTYLO 788 Shrewsbury Avenue TINTON FALLS, NJ 07724			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3688	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/814,104	<b>Applicant(s)</b> BUCHHEIT ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 04/04/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-92 have been examined. Application 10/814,104 (RENDERING CONTENT-TARGETED ADS WITH E-MAIL) has a filing date 03/31/2004.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-23, 25-69 and 71-92 are rejected under 35 U.S.C. 102(a) as being anticipated by Bosarge (US 2003/0191689).

Claims 1 and 47, Bosarge teaches:

A method for facilitating the serving of advertisements with e-mail content, the method comprising:

a) accepting a request for a document including e-mail content (see paragraphs 13-18);

b) generating a request identifier (see paragraphs 13-18);

c) serving the requested document in association with the request identifier (see paragraphs 13-18); and

d) obtaining at least one ad relevant to the e-mail content (see paragraphs 13-18).

Claims 2 and 48, Bosarge teaches:

e) storing the obtained at least one ad (see paragraphs 13-18);

f) accepting an ad request (see paragraphs 13-18);

g) reading the stored at least one ad using information from the ad request (see paragraphs 13-18); and

h) serving the at least one ad read (see paragraphs 13-18).

Claims 3 and 49, Bosarge teaches:

wherein the ad request was sourced by a client device when it rendered the requested document (see paragraphs 13-18).

Claims 4 and 50, Bosarge teaches:

wherein the ad request was sourced by a client device after it rendered the requested document (see paragraphs 13-18).

Claims 5 and 51, Bosarge teaches:

wherein the ad request was sourced by a browser when it rendered the requested document (see figure 1).

Claims 6 and 52, Bosarge teaches:

wherein the ad request was sourced by a browser after it rendered the requested document (see figure 1).

Claims 7 and 53, Bosarge teaches:

wherein the act of storing the obtained at least one ad includes storing the request identifier in association with the at least one ad (see paragraphs 13-18).

Claims 8 and 54, Bosarge teaches:

wherein the request identifier may be used as a primary key to lookup the associated at least one ad (see paragraphs 13-18).

Claims 9 and 55, Bosarge teaches:

wherein the ad request includes the request identifier (see paragraphs 13-18).

Claims 10 and 56, Bosarge teaches:

wherein the act of reading the stored at least one ad using information from the ad request uses the request identifier to lookup the associated at least one ad (see paragraphs 13-18).

Claims 11 and 57, Bosarge teaches:

wherein the act of serving the requested document in association with the request identifier is performed by a first thread, and wherein the act of obtaining at least one ad relevant to content of the e-mail is performed by a second thread (see paragraphs 13-18).

Claims 12 and 58, Bosarge teaches:

wherein the execution of the first thread is independent of the execution of the second thread (see paragraphs 13-18).

Claims 13 and 59, Bosarge teaches:

wherein the act of obtaining at least one ad relevant to content of the e-mail includes submitting an ad request to a content-relevant ad server (see paragraph 32).

Claims 14 and 60, Bosarge teaches:

wherein the ad request includes the request identifier (see paragraphs 13-18).

Claims 15 and 61, Bosarge teaches:

wherein the document including e-mail content represents an individual e-mail message (see paragraphs 13-18).

Claims 16 and 62, Bosarge teaches:

wherein the document including e-mail content represents a group of e-mail messages (see paragraph 58).

Claims 17 and 63, Bosarge teaches:

wherein the document including e-mail content represents an e-mail thread output as a conversation (see paragraph 12).

Claims 18 and 64, Bosarge teaches:

wherein the document including e-mail content is a conversation view including a group of e-mails (see paragraph 12).

Claims 19 and 65, Bosarge teaches:

A method for rendering ads in association with e-mail content, the method comprising:

a) requesting a document including e-mail content (see paragraphs 13-18);

b) accepting the document (see paragraphs 13-18);

c) rendering the document (see paragraphs 13-18);

d) requesting at least one ad relevant to the e-mail content of the document (see paragraphs 13-18);

e) receiving the at least one ad (see paragraphs 13-18); and

f) rendering the at least one ad in association with the rendered document, wherein the at least one ad are rendered after the e-mail content of the document has already been rendered (see paragraphs 13-18).

Claims 20 and 66, Bosarge teaches:

wherein the accepted document includes a request identifier and wherein the act of requesting at least one ad relevant to the e-mail content of the document includes

generating a request including the request identifier (see paragraphs 13-18).

Claims 21 and 67, Bosarge teaches:

wherein the act of requesting at least one ad relevant to the e-mail content of the document occurs after the act of rendering the e-mail content of the document (see paragraphs 13-18).

Claims 22 and 68, Bosarge teaches:

wherein the document is a Web-page (see figure 1).

Claims 23 and 69, Bosarge teaches:

wherein the act of requesting at least one ad relevant to the e-mail content of the document includes constructing a URL that represents a request for at least one ad (see paragraph 54).

Claims 25 and 71, Bosarge teaches:

wherein the document is a Web page, and wherein the act of rendering the at least one ad in association with the rendered e-mail content of the document includes manipulating a document object model of the Web page to render the ads (see paragraphs 13-18).

Claims 26 and 72, Bosarge teaches:

wherein the act of rendering the at least one ad in association with the rendered document is done such that the document is not modified (see paragraphs 13-18).

Claims 27 and 73, Bosarge teaches:



forwarding the document to another client, wherein the at least one ad is not rendered on the other client device (see paragraphs 13-18).

Claims 28 and 74, Bosarge teaches:

wherein the act of rendering the at least one ad in association with the rendered document is done such that the at least one ad does not become a part of the document (see paragraphs 13-18).

Claims 29 and 75, Bosarge teaches:

forwarding the document to another client, wherein the at least one ad is not rendered on the other client device (see paragraphs 13-18).

Claims 30 and 76, Bosarge teaches:

wherein the document including e-mail content is an individual e-mail (see paragraphs 13-18).

Claims 31 and 77, Bosarge teaches:

wherein the document including e-mail content is group of e-mails (see paragraph 58).

Claims 32 and 78, Bosarge teaches:

wherein the document including e-mail content is an e-mail thread (see paragraphs 13-18).

Claims 33 and 79, Bosarge teaches:

wherein the document including e-mail content is a conversation view including a group of e-mails (see paragraph 12).

Claims 34 and 80, Bosarge teaches:

A method for facilitating the serving of advertisements with e-mail content, the method comprising:

- a) accepting a request for a document including e-mail content;
- b) generating a request identifier (see paragraphs 13-18);
- c) serving the requested document in association with the request identifier (see paragraphs 13-18); and
- d) obtaining at least one additional content item relevant to the e-mail content (see paragraphs 13-18).

Claims 35 and 81, Bosarge teaches:

wherein the at least one additional content item is selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see figure 1).

Claims 36 and 82, Bosarge teaches:

herein the at least one additional content item includes at least one content relevant ad and at least one further additional content item selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see figure 1).

Claims 37 and 83, Bosarge teaches:

- e) storing the obtained at least one additional content item (see paragraphs 13-18);
- f) accepting an additional content item request (see paragraphs 13-18);

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g) reading the stored at least one additional content item using information from the additional item request (see paragraphs 13-18); and  
h) serving the at least one additional content item read (see paragraphs 13-18).

Claims 38 and 84, Bosarge teaches:

wherein the at least one additional content item is selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see figure 1).

Claims 39 and 85, Bosarge teaches:

wherein the at least one additional content item includes at least one content relevant ad and at least one further additional content item selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see figure 1).

Claims 40 and 86, Bosarge teaches:

A method for facilitating the serving of advertisements with electronic messaging content, the method comprising:

a) accepting a request for a document including electronic messaging content (see paragraphs 13-18);

b) generating a request identifier (see paragraphs 13-18);

c) serving the requested document in association with the request identifier (see paragraphs 13-18); and

d) obtaining at least one ad relevant to the electronic messaging content (see paragraphs 13-18).

Claims 41 and 87, Bosarge teaches:

e) storing the obtained at least one ad (see paragraphs 13-18);

f) accepting an ad request (see paragraphs 13-18);

g) reading the stored at least one ad using information from the ad request (see paragraphs 13-18); and

h) serving the at least one ad read (see paragraphs 13-18).

Claims 42 and 88, Bosarge teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see paragraph 2).

Claims 43 and 89, Bosarge teaches:

A method for rendering ads in association with electronic messaging content, the method comprising:

a) requesting a document including electronic messaging content (see paragraphs 13-18);

b) accepting the document (see paragraphs 13-18);

c) rendering the document (see paragraphs 13-18);

d) requesting at least one ad relevant to the electronic messaging content of the document (see paragraphs 13-18);

e) receiving the at least one ad (see paragraphs 13-18); and

f) rendering the at least one ad in association with the rendered document, wherein the at least one ad are rendered after the electronic messaging content of the document has already been rendered (see paragraphs 13-18).

Claims 44 and 90, Bosarge teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see paragraph 2).

Claims 45 and 91, Bosarge teaches:

A method for facilitating the serving of advertisements with electronic messaging content, the method comprising:

a) accepting a request for a document including electronic messaging content (see paragraphs 13-18);

b) generating a request identifier (see paragraphs 13-18);

c) serving the requested document in association with the request identifier (see paragraphs 13-18); and

d) obtaining at least one additional content item relevant to the electronic 9 messaging content (see figure 1).

Claims 46 and 92, Bosarge teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see paragraph 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosarge (US 2003/0191689).

Claims 24 and 70, Bosarge does not expressly mention:

wherein the act of requesting at least one ad relevant to the e-mail content of the document further includes instantiating an ActiveX object that takes the URL and requests the at least one ad from a Web-based e-mail server that sourced the document. However, Official Notice is taken that it is old and well known in the promotion art to instantiates an ActiveX object in order to pull an ad. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Bosarge would instantiate ActiveX to obtain ads, as it is old and well known to do so.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
September 18, 2008